

REMARKS

The Office Action mailed May 6, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-10 were pending in the application. Claim 5 has been amended to correct a minor informality. No claims have been canceled or newly added. Therefore, claims 1-10 are pending in the application and are submitted for reconsideration by the examiner.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

§ 103(a) rejection

In the Office Action, claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 4,993,068 to Piosenka et al. (hereafter "Piosenka"), in view of U.S. patent 5,095,196 to Miyate (hereafter "Miyate"). Applicants respectfully traverse these rejections for at least the following reasons.

Applicants submit that the Examiner is relying on hindsight in making the above obviousness rejections of the cited claims under 35 U.S.C. §103(a). Applicants believe that the Examiner is basing the rejection on the mere identification in the prior art of individual components of claimed limitations in the present application. The Examiner has not made particular findings as to the reason a skilled artisan, with no knowledge of the claimed invention, would have selected the components for a combination in the manner claimed in the present application. See, *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). In *In Re Dembiczak*, the court states "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *In Re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC, 1999).

In the present invention, the Examiner notes that in one part of Miyate, Miyate discloses a security system having a **peripheral controller** (see column 3, line 60 to column

4, line 31). The Examiner also notes, that in a different part of Miyate (see column 2, lines 23-34), Miyate discloses alleged benefits of the Miyate **security system**. However, Applicants note that the Examiner has not indicated any teaching in Miyate which suggests that the **peripheral controller** is responsible for the alleged benefits of the **security system**. Therefore, there is no motivation to combine the peripheral controller of Miyate with the personal identification system of Piosenka.

Applicants submit that, as stated above, the claims of the present invention are patentably distinct from the prior art cited by the Examiner and that one ordinarily skilled in the art would not be compelled to combine the elements cited by the Examiner to obtain that which is disclosed and claimed in the present application.

Furthermore, regarding claims 2, 5, and 9, Applicants note that Pionsenka does not disclose storing an identification algorithm on a portable storage media as recited in the claims of the present application. The encryption algorithm discussed by Pionsenka is stored in the encryption apparatus 30 (see column 5, lines 51-64). The physical trait data, along with the other identification data, is encrypted in the encryption device 30 and then stored on the portable storage media (see column 5, line 65 to column 6, line 14). The encryption algorithm itself is never stored on the portable storage media. Further, Miyate does not disclose this feature either. Therefore, the combination of Pionsenka and Miyate does not render claims 2, 5, and 9 obvious.

Conclusion

In view of the foregoing, applicants believe that the application is in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Respectfully submitted,

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